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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

542-012.004

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on 10/6/2008

Signature Kelly Puglio

Typed or printed name Kelly Puglio

Application Number

10/731,524

Filed

December 9, 2003

First Named Inventor

Kenji Hasegawa

Art Unit

1791

Examiner

Mathieu D. Vargot

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 56,885

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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Typed or printed name

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Telephone number

October 6, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: Kenji Hasegawa

Serial No.: 10/731,524

Examiner: Vargot, Mathieu D.

Filed: December 9, 2003

Group Art Unit: 1791

For: Process for preparing polyvinyl alcohol film and polarizing film using the same

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir,

In response to the final Office Action of July 9, 2008, a Notice of Appeal is filed herewith. Applicant respectfully requests a pre-appeal brief conference for reviewing the pending application.

**\*\*\*If any fee and/or extension is required in addition to any enclosed herewith, please charge Account No. 23-0442.**

**CERTIFICATE OF MAILING/TRANSMISSION (37 CFR § 1.8(a))**

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## REMARKS

### Status of the Application

This application includes claims 1, 2, 4 and 5 in which claims 1, 2 and 4 are rejected and claim 5 is withdrawn. A complete list of the pending claims can be found in a previous amendment filed on April 2, 2008.

In the rejected claims, only claim 1 is independent. Claim 1 recites a process for preparing a polyvinyl alcohol (PVA) film. The process comprises the steps of: (1) forming a polyvinyl alcohol film of 30 to 90  $\mu\text{m}$  thickness from a solution of a polyvinyl alcohol resin, and (2) rolling up the film around a cylindrical core made of a metallic material to form a film roll.

Claim 1 further characterizes that the surface hardness of the film roll is set to a Shore A hardness of 60 to 95. The hardness is measured according to JIS K 6301 under conditions of 25°C and 55% RH, and total thickness of the film on the core is no less than that of a 1,000 meters of the polyvinyl alcohol film wound around the cylindrical core. In the process, a guide roll is disposed in the vicinity of the cylindrical core and the film is rolled up around the cylindrical core by passing the film between the core and the guide roll in the state that a space between the core and the guide roll is maintained during the rolling up operation or in the state that the guide roll is in contact with the cylindrical core through the running film.

### Rejection of Claim 1

Claim 1 is rejected under 35 USC §103(a) as being unpatentable over Japanese document 10-138,405 (JP-405 hereinafter) in view of Japanese document Kokai 62-101,421 (JP-421 hereinafter) and Takeuchi et al (US Publication 2003/0089808, Takeuchi hereinafter), and further in view of Corbett (US Patent 3,060,515, Corbett hereinafter). Applicant believes the rejection is clearly in error.

In rejecting claim 1, the Office asserts that JP-405, JP-421 and Takeuchi teach the basic claimed process except that a guide roll being disposed in the vicinity of the core, the guide roll remaining a certain space away from the core during the winding (see page 2, section 2 of the final Office Action of July 9, 2008). Applicant respectfully disagrees.

JP-405 merely teaches laminating a PVA based film with a cellulose film through a rubber laminate roll wherein the surface hardness of the rubber laminate roll is within the range of 70-90 degrees based on Shore A hardness. Previously, the Office has acknowledged that JP-405 lacks: (1) a showing of the winding hardness of the film, (2) the thickness of the film being 30 to 90  $\mu\text{m}$ , (3) using a metallic core, and (4) a length of film wound being at least 1,000 meters (see page 2, section 1 of the non-final Office Action of January 2, 2008).

JP-421 teaches a film roll made of a PET film (not the PVA film specified in the instant application) having a thickness of 6 to 25  $\mu\text{m}$  (outside the claimed range of 30 to 90  $\mu\text{m}$ ). The film is wound around a core to a winding hardness of 88 to 96% as measured by JIS K 6301. JP-421 is different from the instant application at least in that: (1) the material of the film is different, and (2) the thickness of the film is different. The Office previously asserted that the instant thickness of 30-90  $\mu\text{m}$  would have been obvious over 25  $\mu\text{m}$  (see page 2, section 1 of the non-final Office Action of January 2, 2008). Once wound, the teaching of the roll hardness for the PET film would be applicable to other wound films (see page 3, section 3 of the non-final Office Action of January 2, 2008). Applicant respectfully disagrees with the Office's reasoning for combining JP-405 with JP-421.

Like the instant application, JP-421 relates to a process of winding a roll of film. The process is measured by an end result, which is the surface hardness being in a proper range. JP-421 teaches that high dimensional stability of the film is achieved by winding the film to the specified surface hardness of 88 to 96%, which falls into the claimed range of the instant application. However, JP-421 does not teach or suggest that the same process for producing the high quality PET film roll of 6 to 25  $\mu\text{m}$  thickness may be used for producing the PVA film roll of 30-90  $\mu\text{m}$  thickness so as to achieve the same dimensional stability and surface hardness. Previously, Applicant demonstrated to the Office that, due to a significant difference in material properties, especially the hygroscopicity (the ability of absorbing moisture), it is considerably harder to wind a PVA film than to wind a PET film. Therefore, a winding process that is suitable for the PET film is not suitable for the PVA film.

The difference in material properties between PET and PVA is well known, so that these films have completely different applications. For example, PET films are used for making magnetic tapes or floppy discs, whereas PVA films are used for making polarizing

plates for optical devices. Because different film materials require different processing techniques, a person having ordinary skills in the art would not consider applying the process for winding the PET film in winding the PVA film.

Therefore, there is no apparent reason to combine JP-405 and JP-421. Besides, there is clearly no motivation in either one of the references to combine with the other.

JP-421 does not reveal that the film is wound on a metallic core and a length of film being at least 1,000 meters based on which the surface hardness is measured. In order to make up the deficit, Takeuchi is relied upon for teaching the film length and core material, and the Office believes these are rather conventional in the art (see page 3, section 3 of the non-final Office Action of January 2, 2008).

Takeuchi teaches a film roll wherein surface hardness values measured at ten positions along the direction of the core are satisfied with a specific equation. The film roll is particularly used as a base film for a magnetic recording medium. The films are made with polyester or polyamide resins, similar to the PET film of JP-421. The preferred thickness of the polyester or polyamide resin film is 10  $\mu\text{m}$  or less (paragraph [0014]). Therefore, while it is possible that the processes of JP-421 and Takeuchi are combinable because they pertain to the same type of film material, neither JP-421 nor Takeuchi can be combined with JP-405. Again, there is no motivation in any of the references for the combination.

Summarizing the above, applicant respectfully submits that JP-405 cannot be combined with JP-421 and Takeuchi for asserting the basic claimed process of claim 1.

Further in the final Office Action of July 9, 2008, the guide roll feature of claim 1 was asserted to be conventional in the art, and reference is made to Corbett. Corbett teaches winding a roll of thin sheet of a thermoplastic material (called a web), and, as shown in Fig. 1, a guide roll 6 is disposed next to the film roll 3. The guide roll 6 is a so-called dancer roll, which is resiliently mounted (i.e. position not fixed) so as to apply a substantially uniform tension to the web as it is wound upon the center tube 2 (col. 2, lines 6-9). This arrangement is different from that of the present invention where a space between the core and the guide roll is maintained during the rolling up operation or the guide roll is in contact with the cylindrical core through the running film. This means the position of the guide roll is not resiliently movable. What's more, even if Corbett is combined with JP-405 for teaching

adjusting the tension of the PVA film when it is wound on the core, the combination does not have the surface hardness as the control parameter for the winding quality, does not specify a length of film being at least 1,000 meters based on which the surface hardness is measured, and does not reveal that the film is wound on a metallic core.

Based on the above, the rejection of claim 1 is based on a flawed combination of prior art references. Applicant respectfully requests the rejection of claim 1 be reconsidered and withdrawn.

#### **Rejections of Other Claims**

Claims 2 and 4 depend from claim 1 and they are rejected mainly for the same reasons applied to claim 1. Since claim 1 is believed to be patentable, claims 2 and 4 are also patentable at least due to their dependency. Applicant respectfully requests the rejections of claims 2 and 4 be reconsidered and withdrawn.

#### **Canceled of the Non-elected claim**

Currently, claim 5 is withdrawn from consideration. Should the application be allowed, the Office is authorized to cancel claim 5 in an Examiner's amendment.

#### **Conclusion**

It is believed that all the remaining claims in the application are allowable. A decision to withdraw the rejections is respectfully requested.

Respectfully submitted,



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Date: 10/06/2008

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